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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,476	06/24/2003	Edwin G. Duffin	P-9797.00	7245
27581	7590	02/14/2006	EXAMINER	
MEDTRONIC, INC. 710 MEDTRONIC PARK MINNEAPOLIS, MN 55432-9924			KAHELIN, MICHAEL WILLIAM	
			ART UNIT	PAPER NUMBER
			3762	

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SR

Office Action Summary	Application No. 10/601,476	Applicant(s) DUFFIN ET AL.	
	Examiner Michael Kahelin	Art Unit 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) 12-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Cancellation of claims 10 and 11 is acknowledged.

Response to Arguments

2. Applicant's arguments filed 1/26/2006 have been fully considered but they are not persuasive. Applicant amended independent claim 1 to more expressly define the claimed invention. Specifically, Applicant added the limitations of the electrodes being distributed in a circumferential array; and that the axial position of the connector bore contact and lead body contact form a relationship so as to select an electrode, which is in contrast to Sluetz, which merely changes the polarity of the electrodes. However, the amendments to claim 1 fail to differentiate from Sluetz in the "broadest reasonable interpretation" of the amended claim language. Namely, Sluetz's distal electrodes can be interpreted as a "circumferential array" because there are multiple electrodes (an array) that surround the circumference of the lead body. Additionally, the limitation of "selecting an electrode...as a selected electrode" does not differentiate over changing the polarity of electrodes because there is no limitation to what "selected" constitutes. For instance, the Sluetz's electrodes are selected to be positive or selected to be negative.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 5, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Sluetz et al. (Re. 31,990).

5. In regards to claim 1, Sluetz et al. disclose a system comprising an array of circumferential electrodes (68 and 69), an assembly of insulated conductors (65), a lead connector with a linear array of contacts to select an electrode (Fig. 1), a pulse generator with a connector bore (18) wherein at each position of the lead connector, a lead connector contact makes connection with the connector bore contact (16), and a means for reversibly locking the connector along multiple positions in the bore (col. 6, line 21).

6. In regards to claim 2, the connector comprises a second contact that connects with a lead connector contact at each position of the lead connector (17).

7. In regards to claim 5, the means for locking the connector includes a deflectable member projecting into the bore (25).

8. In regards to claim 9, the means for locking includes an actuated member (27 and col. 6, line 3).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 3 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sluetz et al. Sluetz et al. discloses the features of the claimed invention, including the application to a cascaded array of any number of electrodes (col. 3, line 54), as well as a contact that is longer than another contact if elements 5 and 20 are interpreted as being a single contact (because they are electrically connected via 55). Alternatively, Sluetz does teach of providing an electrode selection system with a conductor that engages a device contact at each of several positions to change the electrode configuration from stimulation to sensing, make the ground electrode a stimulating electrode, or alter the output in any other fashion (col. 6,

line 46) with a minimal number of contacts. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Sluetz et al.'s invention with a connector contact that is longer than another connector contact to alter the electrode configuration with a minimal number of contacts.

12. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sluetz et al. in view of Bischoff et al. (5,843,141). Sluetz et al. disclose the essential features of the claimed invention except for an insertion tool and a set of spacers with surface depressions in which deflectable members rest. Bischoff et al. teach of providing a multiple connector lead system with an insertion tool to easily pull the lead into cooperation with the energy applicator and a set of spacers with surface depressions in which deflectable members rest to electrically isolate the electrodes and provide a fixation means for the lead. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Sluetz et al.'s invention with an insertion tool to easily pull the lead into engagement with the energy applicator and a set of spacers with surface depressions in which deflectable members rest to electrically isolate the electrodes and provide a fixation means for the lead. Please note that the surface depressions can be seen in Figure 6.

13. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sluetz et al. in view of Peers-Trevarton (4,469,104). Sluetz et al. disclose the essential features of the claimed invention except for deflectable members that rest in surface depressions on the contacts and deflectable members that rest in depressions apart from the array of contacts. Peers-Trevarton teach of providing a multiple electrode

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connection device with deflectable members that rest in surface depressions on contacts (140) to ensure a close electrical communication between the two contacts and deflectable members that rest in depressions apart from the array of contacts (101) to create a barrier between fluids and the contacts and provide a tight fit for the lead in the bore. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Sluetz et al.'s invention with deflectable members that rest in surface depressions on contacts to ensure a close electrical communication between the two contacts and deflectable members that rest in depressions apart from the array of contacts to create a barrier between fluids and the contacts and provide a tight fit for the lead in the bore. Please note that the examiner is interpreting the surface depression in which the deflectable member rests is the unlabelled feature in proximity to element 172 in Figure 1.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Kahelin whose telephone number is (571) 272-8688. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MWK




GEORGE R. EVANISKO
PRIMARY EXAMINER

2/10/6